

REMARKS

Applicants appreciate the Examiner's thorough examination of the application and request reexamination and reconsideration of the application in view of the following remarks. Applicants also appreciate the Examiner's indication that the subject matter of claims 34 and 35 is allowable.

As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Applicants respectfully request reconsideration of the present application in view of the new claim and the following remarks.

Preliminarily, the Applicants acknowledge that the Examiner has withdrawn the restriction requirement between claims 1 and 21-24 and 33-37. Accordingly, claims 25-32 and 38-47 are withdrawn from the application, and claims 1, 21-24 and 33-37 remain pending in the application.

Through the above amendments, Applicants have amended claim 1 to include the features of claim 21, and amended claim 33 to include the features of allowable claim 34. Additionally, Applicants have cancelled claims 21, 24, 34 and 35, and added new claim 48, which includes the features of original claim 33 and allowable claim 35. No new matter has been added through the above amendments.

Claim Rejections – 35 U.S.C. § 103

"To establish prima facie obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

The Examiner rejected claims 1, 21-24, 33, 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of Muraki et al. (U.S. Patent No. 5,772,494). Applicants respectfully traverse the rejection. As an initial matter, and as noted above, claims 21 and 24 have been cancelled from the application, thus rendering moot the rejection of claims 21 and 24.

I. Independent claim 1

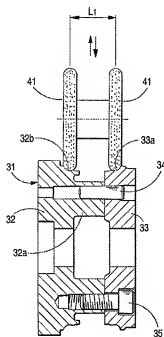
Independent claim 1, as noted above, has been amended to include the features of original claim 21. Independent claim 1, as amended, is directed to a process of machining an outer joint part or an inner joint part of a constant velocity universal ball joint, which outer joint part or inner joint part comprises a longitudinal axis (Aa, Ai) and a number of ball tracks, wherein the ball tracks are each arranged circumferentially in pairs whose central track lines are positioned in planes extending parallel relative to one another, comprising machining the pairs of ball tracks by rotating disc tools whose axes of rotation (R) perpendicularly intersect the respective longitudinal axis (Aa, Ai) at a distance from one another and are held and guided coaxially relative to one another, in the course of machining, guiding the outer joint part or inner joint part linearly in the direction of its respective longitudinal axis (Aa, Ai), and, in the course of machining, guiding the axes of rotation (R) of the disc tools synchronously in a linear or pivoting movement radially relative to the respective longitudinal axis (Aa, Ai).

The Examiner alleged that the AAPA discloses several of the features of independent claim 1, and further alleged that Muraki teaches those features not disclosed by the AAPA. With regard to the features of original claim 21, namely, in the course of machining, guiding the outer joint part or inner joint part linearly in the direction of its respective longitudinal axis (Aa, Ai), and, in the course of machining, guiding the axes of rotation (R) of the disc tools synchronously in a linear or pivoting movement radially relative to the respective longitudinal axis (Aa, Ai), the Examiner alleged that these features, which are not disclosed by the AAPA, are taught by Muraki, and that it would have been obvious to modify the AAPA as taught by Muraki to include these features.

However, Muraki fails to disclose in the course of machining, guiding the outer joint part or inner joint part linearly in the direction of its respective longitudinal axis (Aa, Ai) as claimed in

amended independent claim 1. Muraki is directed to an eccentric orbiting type planetary gear device and its manufacturing method. Figure 6 of Muraki is reproduced below:

FIG. 6



Muraki discloses an orbiting type planet gear device including an internal gear 11, an external gear 21, cam shafts 22, and a supporting block 31 which supports both ends of the cam shafts 22 through taper roller bearings 24. The supporting block 31 includes a supporting member 32 having a plurality of protruded pillar-like portions 32a and a disk 33. The supporting member 32 and the disk 33 are positioned with positioning members 34, and are fastened to each other with fastening members 35. See Col. 3, lines 46-60 and Fig. 6 of Muraki.

The supporting member 32 and the disk 33 of the supporting block 31 have bearing rolling surfaces 32b and 33a which correspond to bearing inner races. Muraki discloses a method of forming the bearing rolling surfaces 32b and 33a in the supporting member 32 and the disk 33. The bearing rolling surfaces 32b, 33a are formed through the use of a pair of grinding stones 41, whose peripheral ends are stepped as required and are mounted on a tool mounting shaft of a grinding attachment such that the grinding stones 41 are spaced apart from each other. The tool mounting

shaft together with the grinding stones 41 is moved to and from the supporting member 32 and the disk 33 to form the bearing rolling surfaces 32b, 33a. See Col. 4, lines 28-37 and Fig. 6 or Muraki.

As noted above, Muraki discloses moving the tool mounting shaft and grinding stones 41 to and from the supporting member 32 and the disk 33 to form the bearing rolling surfaces 32b, 33a. This is the only movement disclosed by Muraki during the forming of the bearing rolling surfaces 32b, 33a. Muraki fails to include any disclosure or teaching of guiding the supporting member 32 and disk 33 linearly in the direction of its longitudinal axis during the formation of the bearing rolling surfaces 32b, 33a.

Indeed, Muraki teaches away from axial movement of the supporting member 32 and disk 33 during the formation of the bearing rolling surfaces 32b, 33a. As shown in Fig. 6 of Muraki, such axial movement of the supporting member 32 and disk 33 would cause the grinding wheels 41 to collide with the supporting member 32 and disk 33, resulting in the destruction of same. Thus, axial movement of the supporting member 32 and disk 33 during the formation of the bearing rolling surfaces 32b, 33a would destroy the device of Muraki.

Therefore, Muraki not only fails to disclose in the course of machining, guiding the outer joint part or inner joint part linearly in the direction of its respective longitudinal axis (Aa, Ai) as claimed by Applicants, but in fact teaches away from this feature. As both Muraki and the AAPA fail to disclose in the course of machining, guiding the outer joint part or inner joint part linearly in the direction of its respective longitudinal axis (Aa, Ai) as claimed by Applicants, the combination of references fails to disclose each and every feature of independent claim 1. Accordingly, independent claim 1, and dependent claims 22 and 23, are patentable over the references for at least this reason. Moreover, it should be noted that dependent claims 22 and 23 each contain additional recitations that are separately patentable as well.

II. Independent claim 33

Applicants acknowledge and appreciate the Examiner's indication that dependent claims 34 and 35 would be allowable if rewritten in independent form. Merely to advance the prosecution of the subject application, Applicants have amended independent claim 33 to include the features of allowable claim 34. Accordingly, independent claim 33, and dependent claims 36 and 37, are in condition for allowance for at least this reason.

Additionally, Applicants include new independent claim 48, which includes the features of original independent claim 33 and allowable dependent claim 35. Accordingly, independent claim 48 is in condition for allowance for at least this reason.

Conclusion

In view of the above remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 66967-0037 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: December 1, 2009

Respectfully submitted,

Electronic signature: /Jason D. Shanske/
Jason D. Shanske
Registration No.: 43,915
Kristin L. Murphy
Registration No.: 41,212
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 84362
Attorneys for Applicant